



TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO CA 94111-3834

COPY MAILED

JUL 05 2005

OFFICE OF PETITIONS

In re Application :
Soane, et al. :
Application No. 10/083,316 : DECISION ON APPLICATION
Filed: February 25, 2002 : FOR PATENT TERM ADJUSTMENT
Atty Docket No. 021674-000251US :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)", filed March 29, 2005. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from one hundred ninety-seven (197) days to four hundred seventy-nine (479) days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein. However, applicants' request that an additional PTO delay of one hundred sixty (160) days be assessed is being **HELD IN ABEYANCE** until after the actual patent date.

Applicants are given two months from the issue date of the patent to request reconsideration of the patent term adjustment indicated on the patent application. Applicants may seek such reconsideration without payment of the fee. A copy of this decision should accompany applicant's written request for reconsideration.

On January 4, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is one hundred ninety-seven (197) days. On March 29, 2005, applicants timely¹ submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is four hundred seventy-nine (497) days.

Applicants state that the patent issuing from the application is subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of one hundred ninety-seven (197) days based on an adjustment for PTO delay of one hundred sixty-seven (167) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1) and one hundred fifty-two (152) days pursuant to 35 U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. § 1.703(a)(2), reduced by applicants' delay of one hundred twenty-two (122) days for filing a supplemental response (a terminal disclaimer), pursuant to 37 C.F.R. § 1.704(c)(8). The adjustment of one hundred twenty-two (122) days is at issue.

The adjustment of one hundred twenty-two (122) days has been found to be incorrect. Applicants should not have been assessed delay pursuant to 37 C.F.R. § 1.704(c)(8) for filing a supplemental reply (a terminal disclaimer) on August 5, 2004. A review of the application file reveals that the terminal disclaimer was in fact filed together with an Amendment on April 5, 2004, not August 5, 2004.

In addition, applicants assert additional PTO delay of one hundred sixty (160) days for the failure on the part of the Office to issue the patent within three years of its filing. However, the Office does not assess whether or not any additional PTA is accorded in this instance until the issue date is established.²

¹ PALM records indicate that applicant filed the PTA prior to payment of the issue fee.

² Applicants should note that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period of pendency before the Office except for periods excluded under 35 U.S.C. (b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A).

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **three hundred nineteen (319) days** (319 (167+152) days of PTO delay and 0 days of applicant delay).

The \$200 fee set forth in 37 C.F.R. § 1.18(e) has been charged to Deposit Account No. 20-1430, as authorized.

The application file is being forwarded to the Office of Patent Publication for timely issuance of the patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

Karin Ferriter

yes
Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen